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REMARKS

This Amendment is responsive to the Office Action dated February 10, 2004. Claims 1 - 3 and 5 - 7 are pending in this application and have been rejected. Reexamination is respectfully requested in light of the foregoing amendments in the claims and the following remarks.

In the outstanding Office Action there are no rejections based upon prior art. Instead, claims 1 - 3 and 5 - 7 are rejected under 35 USC § 112 (second paragraph) which provides as follows:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention"

At page 2, beginning at line 14, the Examiner requests clarification with respect to the antecedent basis for the "planar KGD surface". Clarification has been made in claim 1 as requested.

Page 1, Line 17 of Office Action

In the paragraph beginning at page 1, line 17, the Examiner first cites MPEP § 2113 as authority for the rejection. It is respectfully requested that the Examiner refer to § 2113 and note that § 2113 relates not to 35 USC § 112, but to rejections based

upon prior art. Every case cited in § 2113 related to a prior art rejection. Here the Examiner presents a unique argument that the process limitations render the claimed device indefinite because a potential infringer would not be aware of a clear scope of structure being claimed by the process steps. This test is simply not found in § 2113. In fact, the test is clearly contradicted by the statute itself. 35 USC § 287 makes it incumbent upon the patent owner to provide constructive or actual notice to the infringer in order to collect any damages at all. Therefore, the infringer will be notified by the patentee. It is the patentee's duty to find the infringer. Next, as a matter of trial procedure, it is the patentee's burden of proof to prove infringement under 35 USC § 271. It is the patentee who must muster the facts of infringement against a potential infringer. Still further, the "potential infringer" if he manufactures the claimed known good die and device together will certainly know the process used to make the Known Good Die. On the other hand, should the "potential infringer" purchase his dies, he will certainly have the ability to find out if his device contains dies which have or have not been tested. The "potential infringer" is a hypothetical person who has no standard for determination. Applicant cannot respond to such an allegation because the Examiner has presented no evidence as to the level of skill of a potential infringer.

Next, at page 2, line 19 the Examiner refers to scope of structure. The file history of this application provides an answer. There is no rejection on prior art. Therefore, there

must be a structural difference (see MPEP § 2113). Such a structural difference was previously outlined to the Examiner in Applicant's paper filed September 10, 2003 in discussion of the rejection under 35 USC § 102. The "potential infringer" need only refer to this to determine one of the differences which have apparently been recognized by this Examiner in dropping the rejection under 35 USC § 102.

The clear test for product by process claim patentability is prior art, not some potential future infringement. Claims are not unpatentable because of a potential future infringer. Instead, claims once patented provide the basis for actions against future potential infringers.

At page 2, lines 20 - 24, the Examiner first notes that how the device was tested to describe the structure is part of its history. Next, the Examiner states, "so what one must sk is: what happens to a structure that was 'thermal stress tested'?" The answer is simple. As taught in Applicant's specification the thermal test tolerance screening is used to eliminate dies which do not past the test. Stated another way, dies that fail the test never appear in an end use device in the first place. This is one indicia of what happens. Next, the Examiner asks, "What does it look like ...?" The answer is that it works when others do not. Stated more simply, the device that does not pass the thermal stress test becomes broken and it never appears as a Known Good Die in the first place. Two computers can "look" alike, but the programming or chip structure may differ. The test for

infringement in the computer example is if the software or hardware responds to claims of a patent.

In MPEP § 2113, second paragraph, In re: Garnero, 412 F.2d. 276, 162 USPQ 221 (CCPA 1979) is cited. This case, when read shows that Applicant's claim is clearly allowable. The case, as stated in head note 1 stands for the proposition that "mere presence of method limitation in article claim which is otherwise allowable does not so poison claim as to render it unpatentable."

In this case, there was a rejection under 35 USC § 103 and the Court stated that it was the structural limitation that defines the invention. Here, the Examiner has obviously found the correct structural limitation (see Reasons for Allowance) and has withdrawn the rejection under 35 USC § 102 as outlined above for the reasons stated in the previous arguments filed on September 10, 2003. The Garnero decision also relies upon ex parte Lindberg 157 USPQ 606 (1967). In Lindberg, the Court considers possible ambiguity in the claim. The ambiguity was raised by the Examiner. Here the Examiner has not addressed claim language at all. The Examiner, instead asked "What does it look like compared to when it is not tested?" This is not an ambiguity, this is something that is not even in the claim. The Examiner simply does not state what is ambiguous about a thermal stress tolerance test prior to mounting the KGD on the end use device by a device connected to the KGD by the wire bond connections, or in the alternative, by the solder ball connections. This step and method is clear and has nothing to do with what the device looks like. As stated above, the end

result is that the device works or it does not as set forth in Applicant's specification. The thermal stress test sorts out failures or potential failures yielding a more reliable KGD and device having the KGD.

Still further, it should be noted that the rejection of claim 6 (in Lindberg) on the grounds of 35 USC § 112 was on a relation of which electrodes are near a junction. This is a structural limitation, not a method limitation and, therefore, is not pertinent to the rejection the Examiner attempts to make here.

Yet another difference between the KGD of Applicant's claim 1 and the prior art is that the devices containing KGD's of Applicant's invention are less failure prone, as explained in Applicant's specification. The purpose of the stress test recited in the claim is to determine which KGD's are indeed "good".

Claim 2

The Examiner in questioning claim 2 has apparently ignored the last seven words of claim 2 which states that the other remains pristine until connected to the end use device. What this means to the end use device is that they are connected to the end use device and, therefore, are not pristine in the final end use device. The language is unequivocally clear. This is what "until connected to the end use device" means.

Claim 3

Claim 3 has been canceled.

Claim 5

The rejection of claim 5 is once again predicated on "structure for a potential infringer". This, as pointed out above, is totally irrelevant to MPEP § 2113 which describes rejections which are all based upon prior art rejections. However, claim 5 even presents structure which is visible by an end use device user. All they have to do is look at it and determine that the wire bond connections or solder ball array connections have not been removed from the die. The scope of the structure as questioned by the Examiner is claim 5 plus claim 1. Still further, it is stated that the connections are not removed from the die. This, however, does not mean that the connections are not removed from the test device which is referred to in claim 1. The bonds referred to in claim 1 are bonds to a test structure and the bonds referred to in claim 5 are the ones on the die. Again, in the last sentence of the rejection in claim 5, the Examiner refers to the potential infringer test allegedly found in MPEP § 2113. Such a test simply does not exist in § 2113, or any place else that Applicant has found in patent law. (See discussion above with respect to § 2113, 35 USC § 287 and 35 USC § 271.)

Claim 6

Claim 6 further adds to claim 1 that the connections to the test device are metallurgical connections. On the other hand, the rejection states "in claim 6, the test connections are "metallurgical connections" but the end use device was already

tested. So metallurgical connections are no longer connected in the end use device. This does not comport with the claim. In claim 1, the KGD is thermal stress tolerance tested prior to mounting by a test device connected to the KGD by wire bond connections, or in the alternative, by solder ball connections. Both wire bond and solder ball connections are known to be metallurgical connections as described in Applicant's specification. The wire bonds are not being removed from the structure of claim 1 as the Examiner argues. Instead, the wire bonds are explained as being metallurgical connections. As a structural claim, the wire bonds are part of the additional structure provided in claim 6 over claim 1. Stated another way, claim 1 does not state metallurgical connection. Claim 6 does. The Examiner asks, "So what is the scope of "metallurgical connections" that are *no longer connected*?" The Examiner has failed to read the claim as a whole. The connection described is that to the test device. Claim 1, however, in the last paragraph further states that the connections used for the Known Good Die test are not connected to the end use device or any other device. This disconnects them, but claim 6 merely states that they are a metallurgical connection when connected as stated in the wherein clause beginning "wherein the KGD is a KGD which is thermal stress tolerance tested . . ." in claim 1.

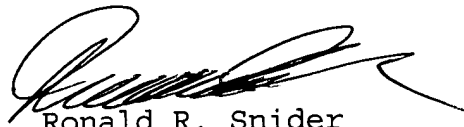
Allowable Subject Matter

At page 4, paragraph number 5, the Examiner states as reasons for allowance the pristine distinction found in claim 2. It is noted that this limitation is not stated as "pristine" in claim 1. Instead, Applicant contends that the distinction of claim 1 over the prior art lies in part in the planar surface as explained by Applicant in the paper filed September 10, 2003. With respect to "pristine" at claim 2, Applicant respectfully submits that claim 2 is understandable under 35 USC § 112 because pristine in the end use device does not exist. The claim states "until connected to the end use device". The Examiner has clearly understood this, in his discussion in the last two paragraphs of page 4.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action in accordance thereof is requested. In the event there is any reason why the application cannot be allowed in this current

condition, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems by Interview or Examiner's Amendment.

Respectfully submitted,



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Reg. No. 24,962

Date: February 26, 2004

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corroborating affidavits that his supporting witnesses had knowledge adequate to supply vitally necessary corroboration as to reduction to practice or diligence.

We agree with the board's conclusion. It is clear from the above quotations that none of the so-called corroborating witness affidavits makes any reference to even one of the process limitations of the count. As the appellee said to the board, "The probative significance of these averments is nil * * *." Nothing is left except the averments of the inventor himself and his own notebook. Examination of the notebook shows that it was kept by Kistler himself and is unwitnessed. The supporting witnesses said no more, in effect, than that they had seen the notebook in his laboratories, along with the equipment and bottles. They did not say they knew anything of its contents. Therefore, they have not corroborated anything it contains.

Consideration of Kistler's Supplemental Brief shows that his theory of this case is that he does not have to prove his facts at this stage of the interference but only give rise to an inference or show a possibility that he could prove them later, which he says should suffice to prevent summary judgment:

* * * Appellant should be entitled to a trial on the merits. For now, it is sufficient that we can say when considering the purpose for which the affidavits were made, that there is a reasonable possibility that the corroborating affiants possessed the knowledge required. [Emphasis ours.]

* * *

Moreover, a determination of whether or not the corroborating affiants had actual knowledge of the steps of the process or of testing is premature; such a determination bears only upon the weight to be given their subsequent testimony.

We cannot accept this procedural theory. To do so would entirely vitiate the purposes of Rules 204(c) and 228 and allow mere uncorroborated assertions to take the place of proof of acts and circumstances adequate to overcome Weber's March 9, 1960, filing date.

The decision of the board is *affirmed*.

Court of Customs and Patent Appeals

In re GARNERO

No. 8172 Decided June 26, 1969

PATENTS

1. Claims—Article defined by process of manufacture (§ 20.15)

Mere presence of method limitation in article claim which is otherwise allowable does not so poison claim as to render it unpatentable.—In re Garnero (CCPA) 162 USPQ 221.

2. Claims—"Comprising," "Consisting," etc. (§ 20.30)

"Consisting essentially of" terminology in claim excludes additional unspecified ingredients which would affect basic and novel characteristics of product defined in balance of claim.—In re Garnero (CCPA) 162 USPQ 221.

Particular patents—Structural Material

Garnero, Structural Material of Expanded Minerals and Method for Manufacture, claims 1 and 9 of application allowed.—In re Garnero (CCPA) 162 USPQ 221.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Anthony L. Garnero, Serial No. 381,145, filed July 8, 1964; Patent Office Group 160. From decision rejecting claims 1 and 9, applicant appeals. Reversed.

See also 145 USPQ 457.

HERMAN HERSH and McDOUGALL, HERSH, SCOTT & LADD, both of Chicago, Ill. (GEORGE A. DEGNAN, Washington, D. C., of counsel) for appellant.

JOSEPH SCHIMMEL (FRED W. SHERLING of counsel) for Commissioner of Patents.

Before RICH, Acting Chief Judge, HOLTZOFF and McLAUGHLIN, Judges, sitting by designation, and ALMOND and BALDWIN, Associate Judges.

BALDWIN, Judge.

This appeal is from the Patent Office Board of Appeals decision affirming the examiner's rejection of two claims¹ of appellant's application² as unpatentable

¹ The rejections of only claims 1 and 9 are pursued on appeal here.

² Serial No. 381,145, filed July 8, 1964, for "Structural Material of Expanded Minerals and Method for Manufacture," allegedly a continuation of application serial No. 714,331, filed February 12, 1958, for "Structural Material of Expanded Minerals and Method for Manufacturing." The parent application was before this

under 35 U.S.C. 103, claim 1 being rejected on Thomas³ in view of Pierce⁴ and claim 9 being rejected on the same combination of references further in view of Ford.⁵ No claim has been allowed.

The Invention

The invention relates to a thermal insulation panel formed from expanded perlite particles. The particles are held together without any additional material, such as an external bonding agent, by interfusion between the surfaces of the perlite particles. Interfusion is effected by taking the initially unexpanded perlite particles and heating them rapidly for expansion so that combined water associated with the particles is released as a vapor which operates as a flux which enables the particles to become stuck together at temperatures as low as 1400° F.⁶ The specification describes the product as "having a density which may vary from 1 pound per cubic foot to as much as 80 pounds per cubic foot while still maintaining a porosity and a mass integrity sufficient to enable use thereof as a structural insulation material."

Claims 1 and 9 read:

1. A composite, porous, thermal insulation panel characterized by dimen-

court in *In re Garnero*, 52 CCPA 1370, 345 F.2d 589, 145 USPQ 457 (1965), and we there affirmed the rejection of claims directed to a method of manufacturing an expanded perlite structure as being obvious under 35 U.S.C. 103 in view of certain, different prior art cited in that case.

³ U. S. Patent 2,600,812, issued June 17, 1952.

⁴ U. S. Patent 2,517,235, issued August 1, 1950.

⁵ U. S. Patent 2,691,248, issued October 12, 1954.

⁶ Thus, appellant's specification states:

Fusion believed to be necessary for adhesion occurs with the average perlite at a temperature within the range of 2000-2200° F. It has been found, however, that the combined water which is released as a vapor when the perlite particles are heated to a pyroplastic state operates as a flux which enables the desired stickiness to develop for agglomeration when the particles are heated to a temperature as low as 1400° F. but preferably at a temperature above 1600° F. Thus agglomeration can be achieved at a temperature starting at 1400° F. Best adhesions and expansions are secured when the particles are heated to a temperature above 1800° F. Thus the preferred conditions for operation from the standpoint of expansion and agglomeration will reside in heating the particles to a temperature of 1800-2200° F.

sional stability and structural strength consisting essentially of expanded perlite particles which are interbonded one to another by interfusion between the surfaces of the perlite particles while in a pyroplastic state to form a porous perlite panel.

9. An insulation panel as claimed in Claim 1 in which the panel is formed in cross-section with layers of different densities.

The References

Thomas discloses a pipe insulating composition which utilizes sodium silicate as a binding agent to hold already expanded perlite particles together, with sodium chloride being used as a setting agent. A mixture of the expanded perlite, the sodium silicate binder, and the sodium chloride setting agent are subjected to a compression from 5 to 7 tons per square foot, at ambient temperature, to produce articles formed of the composition. Prior to compression, Thomas' aggregate mixture has a density of 4 to 10 pounds per cubic foot.

Pierce discloses a building material utilizing expanded perlite particles which are mixed with hot hydrated lime (CaO) at a temperature of about 300° F. Pierce states that "the exterior of the granules reacts chemically to bind the entire mass together." The specification discloses that the end product may have a density of 40-50 pounds per cubic foot.

Ford discloses cellular glass pellets having a core of highly cellulated glass an intermediate layer of less highly cellulated glass, and an outer layer of substantially uncellulated glass, thus demonstrating a panel having a cross-section of varying density.

The Rejection

Sustaining the examiner's rejection of claim 1 as being unpatentable over Thomas in view of Pierce under 35 U.S.C. 103, the board stated:

The language used by Pierce is considered to be readable on "interbonding by interfusion" as expressed in the claims at issue. Albeit that the condition limitations appear to differ somewhat from the details of the process described by the patentees we are apprised of no facts which would lead us to conclude that the instantly claimed product necessarily would be patentably unique when compared to that resulting from the prior art methods.

The board rejected arguments by appellant that the inclusion in the claim of the phrase "consisting essentially of" would exclude the presence of an ex

ternal binder and thus distinguish from the composition of Thomas which uses a sodium silicate binder and that the phrase "expanded perlite particles which are interbonded one to another by interfusion between the surfaces" distinguishes from the chemical bonding of Pierce which employs lime as an additional ingredient. Instead the board noted the existence of other claims (now cancelled) adding other limitations to claim 1 and stated:

[T]he recital of "consisting essentially" renders a claim open only for the inclusion of unspecified ingredients which would not materially affect the basic and novel characteristics of the product defined in the balance of the claim. * * * Where, as here, other claims indicate that particular components are not excluded by the words "consisting essentially of", appellant's arguments as to the existence of diverse reaction mechanisms in the prior art processes cannot be accepted as conclusive of a factual patentable distinction in his claimed product.

The examiner's rejection of claim 9 on the ground that the feature of different densities in different layers would be an obvious modification in view of Ford, was affirmed by the board in that:

Appellant has urged no patentable merit in the specific modifications set forth in claims 5 through 9, and we perceive none.

Opinion

On appeal the solicitor's position appears to be that the only distinction between appellant's *product* and the *products* of the prior art is the *process* by which appellant's product is made; and, as that *process* has been found to be unpatentable in our previous decision of *In re Garnero*, 52 CCPA 1370, 345 F.2d 589, 145 USPQ 457 (1965), then the *product* claims are likewise unpatentable. The solicitor is in effect reading claim 1, which recites "expanded perlite particles which are interbonded one to another by interfusion between the surfaces of the perlite particles while in a pyroplastic state to form a porous perlite panel," as a product claim containing a process limitation and then applying the rationale expressed by this court in *In re Stephens*, 52 CCPA 1409, 345 F.2d 1020, 145 USPQ 656 (1965); and *In re Dilnot*, 49 CCPA 1015, 300 F.2d 945, 133 USPQ 289 (1962).

The trouble with the solicitor's approach is that it necessarily assumes that claim 1 should be construed as a prod-

uct claim containing a process, rather than structural, limitation. However, it seems to us that the recitation of the particles as "interbonded one to another by interfusion between the surfaces of the perlite particles" is as capable of being construed as a structural limitation as "intermixed," "ground in place," "press fitted," "etched," and "welded," all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations.⁷ The correct inquiry therefore, it appears to us, is whether the product defined by claim 1 is patentably distinguishable over the disclosures of Thomas and Pierce in view of the *structural* limitation defining the panel as "consisting essentially of expanded perlite particles * * * interbonded one to another by interfusion between the surfaces of the perlite particles."⁸ Neither Thomas nor Pierce disclose expanded perlite particles *interbonded one to another by interfusion between the surfaces thereof*; it is not therefore reasonable to view such interbonding to be obvious by considering the references collectively.

[2] Moreover, the "consisting essentially of * * *" terminology would, as the board pointed out, exclude additional unspecified ingredients which would affect the basic and novel characteristics of the product defined in the balance of the claim. However, to follow the teachings of Thomas combined in any manner with Pierce, would require the presence of at least one additional material with the expanded perlite, whether it be the sodium silicate binder of Thomas or the hydrated lime which Pierce uses to provide a chemical joining action. In either event it cannot be said that the additional ingredient would not materially affect the basic

⁷ Saxe and Levitt, *Product by Process Claims and Their Current Status in Chemical Patent Office Practice*, 42 JPOS 528, 536, 537 (August 1960), and cases collected thereat.

See also a recent decision of this court in *In re Steppan*, 55 CCPA 791, 394 F.2d 1013, 156 USPQ 143 (1967), in which we found that use of the term "condensation product" in a chemical claim to a product did not thereby render the claim a product-by-process claim.

[1] ⁸ Taking the view we do that the just recited limitation is structural in nature we do not find it necessary to consider the additional recitation "while in a pyroplastic state * * *" as the mere presence of a method limitation in an article claim which is otherwise allowable would not so poison the claim as to render it unpatentable. *Ex parte Lindberg*, 157 USPQ 606 (P.O. Bd. App. 1967).

and novel characteristic of appellant's product which is that the perlite particles are held together *without* any additional material.

The rejections of claims 1 and 9 are therefore *reversed*. As to claims 2 and 5-8, the other claims initially appealed but not pursued, the appeal is dismissed.

McLAUGHLIN, Judge, concurs in the result.

Court of Customs and Patent Appeals

In re JONES

No. 8099 Decided July 3, 1969

PATENTS

Particular patents—Polypropylene

Jones, Filled Polypropylene, claims 1 and 2 of application refused.—In re Jones (CCPA) 162 USPQ 224.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Roger F. Jones, Serial No. 123,096, filed July 11, 1961; Patent Office Group 140. From decision rejecting claims 1 and 2, applicant appeals. Affirmed.

ROGER V. N. POWELSON and DONALD R. JOHNSON, both of Philadelphia, Pa., for appellant.

JOSEPH SCHIMMEL (JOSEPH F. NAKAMURA of counsel) for Commissioner of Patents.

Before WORLEY, Chief Judge, and RICH, ALMOND, and BALDWIN, Associate Judges.

BALDWIN, Judge.

Jones appeals from the Patent Office Board of Appeals decision affirming the examiner's rejection of claims 1 and 2, the only remaining claims in his application,¹ as unpatentable over Ward,² Blake,³ and Orzechowski,⁴ taken in combination, under 35 U.S.C. 103.⁵

¹ Serial No. 123,096, filed July 11, 1961, for "Filled Polypropylene."

² U. S. Patent 2,835,107, issued May 20, 1958.

³ U. S. Patent 2,993,799, issued July 25, 1961, on an application filed August 20, 1957.

⁴ U. S. patent 3,166,542, issued January 19, 1965, on an application filed February 3, 1961.

⁵ In his brief, appellant has urged that "[i]n the latter part of its opinion the

The Invention

The invention relates to blends containing polypropylene and anthophyllite asbestos.⁶ The specification indicates that articles molded from asbestos-filled polypropylene generally "exhibit enhanced tensile and flexural modulus" however, under certain circumstances, specifically where the articles are to sustain prolonged exposure to moderate high heat,⁷ the asbestos-filled compositions tend to oxidize and degrade more rapidly than unfilled polypropylene. Appellant has discovered that *anthophyllite* asbestos accelerates the oxidative degradation to a far lesser extent than do other asbestos.

The appealed claims read:

1. As a new composition of matter: a blend of crystalline polypropylene and anthophyllite asbestos, wherein the weight percent of asbestos is from 10% to 85%, together with a small but effective amount of an inhibitor against thermal and oxidative degradation.

2. The composition according to Claim 1 in which the weight percent asbestos is from 30% to 60%.

The References

Ward discloses compositions of asbestos with thermosetting resins, a number of which are listed as being applicable and all types of asbestos are disclosed as acceptable. The preferred composition, however, comprises phenol-formaldehyde condensation resin with *anthophyllite* asbestos which has been chemically treated to eliminate acid soluble metallic constituents. The composition

Board of Appeals is apparently rejecting the claims as not being supported by sufficient disclosure." We do not consider that the board was postulating a new ground of rejection under Rule 196(b) but rather was only commenting on the adequacy of the showing of unexpected results.

⁶ Asbestos is the generic name given to a group of naturally-occurring fibrous magnesium silicate minerals. There are two basic types: serpentine or long-fiber asbestos (chrysotile) and amphibole (short-fiber asbestos (tremolite, actinolite, amosite, crocidolite and anthophyllite). The latter type combine various amounts of iron, calcium and sodium silicates with the magnesium silicate. They are said to be generally brittle and cannot be spun as can chrysotile, but are more resistant to chemicals and heat. Condensed Chemical Dictionary 113 (6th ed. 1961).

⁷ 280° and 310° F. are the only two temperatures mentioned in the specification. The intended use for the compositions may be "under the hood of an automobile in distributor caps, for example."

etics, hair cosmetics, perfumes or water. Each woman was then a small holder on which were tied a cylindrical jar of "RE-ETE" hair conditioner and a regular base of an unidentified "RE-UE" product and asked: "Here are packages of toilet goods, would you say that they were made by the same company or by different companies?"

A witness was then handed a pre-prepared statement by the inventor containing the statement, "I thought that both products were made by different companies", which was signed. All eight women appeared as witnesses for applicant and were subjected to cross-examination.

We can consider applicant's efforts as to regard to be a "survey", there are some blatant omissions and defects in, namely, the formulator and one of the persons conducting the survey was applicant's counsel; neither this nor any of the other persons who conducted the interviews were called as witnesses; the total number of persons interviewed and the number of responses unfavorable to applicant, if any, were not disclosed; and the sample of persons only in Minneapolis, Minnesota is hardly indicative of what the situation may be "in commerce" nationally. But, even considering the testimony of these eight witnesses alone, no probative value can be ascribed to it in resolving the issue before the Board. The testimony reveals that a number of the witnesses were influenced by factors other than the marks themselves, namely, the difference in the style of lettering, the differences in the physical appearance of the packages, and similar factors immaterial and irrelevant to whether or not the marks "RE-ETE", and "REPLIQUE" are similar. See: *The Tas-T-Nut Company v. Nut & Date Company*, 128 F.2d 166 (TT&A Bd., 1961), and cases therein, affirmed 134 USPQ 349 (TT&A Bd., 1962). The "survey", more-over, afforded the interviewers a side-by-side comparison of the marks which is basically an improper method of analysis of marks in a proceeding of this character because purchasers do not usually examine marks side-by-side even in those situations where the goods may be sold off the same shelf; and they ordinarily retain a general rather than a specific recollection of marks and are usually governed by a vague recollection in making purchases.

Turning therefore to the marks "RE-ETE" and "REPLIQUE", there is no difference in meaning in that the latter signifies "refill" or "replenish"

whereas to the French speaking portion of the American consumer, the latter will indicate "reply". However, "RE-ETE" and "REPLIQUE" are substantially similar in appearance for they are two syllable marks starting with the same four letters and ending with the same letter, and considering that a French term such as a "REPLIQUE" could and would be pronounced in different ways by persons both familiar with and unfamiliar with the French language, these marks would be susceptible of a similar pronunciation. The similarities between the marks in these respects are believed sufficient to give rise to a likelihood of confusion or mistake as to the source of the goods sold thereunder with resultant damage to opposer.

Decision

The opposition is sustained; and registration to applicant is refused.

Patent Office Board of Appeals

Ex parte LINDBERG

Patent issued Feb. 20, 1968

Opinion dated June 30, 1967

PATENTS

1. Claims—Article defined by process of manufacture (§ 20.15)

Patent Office permits method limitations in article claim if article cannot be described in any other way; moreover, mere presence of method limitation in article claim which is otherwise allowable does not so poison claim as to render it unpatentable. — *Ex parte Lindberg* (PO BdApp) 157 USPQ 606.

Particular patents — Semiconductor Device

3,370,185, Lindberg, Semiconductor Device for Demonstrating the Hall Effect, claims 1 to 5 and 7 to 10 of application allowed; claim 6 refused.—*Ex parte Lindberg* (PO BdApp) 157 USPQ 606.

Appeal from Group 250.

Application for patent of Albert Lindberg, Serial No. 311,168, filed Sept. 24, 1963. From decision rejecting claims 1 to 10, applicant appeals. Affirmed as to claim 6; reversed as to claims 1 to 5 and 7 to 10.

SPENCER & KAYE, Washington, D. C.,
for applicant.

Before KREEK, KEELY, and STRADER, Ex-
aminers in Chief.

STRADER, Examiner in Chief.

This is an appeal from the final re-
jection of claims 1 through 10, all the
claims in the case.

The references relied on are:

Dunlap, 2,736,822, Feb. 28, 1956
French Patent, 1,077,185, Apr. 28,
1954

Claims 1 through 10 stand rejected
as "unpatentable over Dunlap in consid-
eration with the French reference pur-
suant to 35 U.S.C. 103." It is not clear
why the French patent was applied
against all ten claims because it ap-
pears that the only feature for which
the French patent is relied on is the
split electrode and this limitation is
present only in claims 2, 9 and 10. It
appears from the examiner's arguments
that he considers claims 1 and 3 through
8 to be obvious in view of Dunlap
alone.

The examiner apparently considers
Figures 7 and 8 to be the most perti-
nent figures of Dunlap and contends
that lines 28-33 in column 7 of Dunlap
suggest monitoring both sides of the
P-N junction. Even assuming arguendo
that Dunlap does suggest monitoring
both sides of the P-N junction, the
examiner does not point out how he
proposes to modify Figure 7 or Figure
8 of Dunlap to carry out this sugges-
tion. With respect to the statement in
column 7 of Dunlap, we agree with ap-
pellant's comment on pages 1 and 2 of
his reply brief. We find no suggestion
anywhere in Dunlap of providing Hall
voltage pickup electrodes and transverse
current feeding electrodes on both sides
of a P-N junction. This limitation or
the equivalent appears in each of the
claims on appeal. Accordingly, we will
not sustain this rejection.

[1] Claim 3 stands rejected under 35
U.S.C. 112 as providing an improper
method limitation to an article claim. It
has long been Office policy to permit
method limitations in a claim to an ar-
ticle if the article could not be de-
scribed in any other way. The examiner
contends in his Answer for the first
time that the presence of other article
claims indicates that the article can be
claimed without the method limitation.
We note, however, that these other ar-
ticle claims are not drawn to the ar-
ticle defined by claim 3. Appellant, on
the other hand, contends that it is im-
possible to define the article of claim

3 without resort to the method. Accord-
ingly, we will not sustain this rejection
(Ex parte Donahey, 126 USPQ 61). We
note that claim 3 is dependent on and
further limits claim 1. We have indi-
cated that we would not sustain the ex-
aminer's rejection of claim 1. The mere
presence of a method limitation in an
article claim which is otherwise allow-
able would not so poison the claim as
to render it unpatentable.

We have considered the examiner's
arguments with respect to difficulties in
the examination of applications in this
art which would arise if a majority of
the applications included article claims
with method limitations. Although this
difficulty, which might arise, would not
give any statutory basis for rejecting
such claims, it could provide a reason
to be considered with respect to chang-
ing the internal policy of the Office in
the assignment of applications for ex-
amination.

Claim 6 stands rejected as indefinite
under 35 U.S.C. 112 on the ground that
it is not clear which electrodes are near
the junction. We agree entirely with the
examiner's well reasoned explanation on
page 9 of his Answer. We have care-
fully considered appellant's argument in
his brief, which is almost a tacit ad-
mission that the claim is ambiguous, but
we are not persuaded thereby. The sec-
ond paragraph of Section 112 places
upon applicant the burden of particu-
larly pointing out and distinctly claim-
ing. The ambiguity of this claim is not
cured by the explanation in appellant's
brief. We will sustain this rejection.

The decision of the examiner is af-
firmed as to the rejection of claim 6
under 35 U.S.C. 112 and is reversed as
to claims 1 through 5 and 7 through 10.

The Board also criticized appellant's survey, and the Board interpreted the survey results as showing that the remaining 16% to 25% of the consumers sampled "would have recognized BUNDT as the name of a type of cake rather than the Pillsbury cake mix brand." *Id.* 221 USPQ at 1115. Although we do not find support for the Board's reasoning on this point, we do agree with the Board that this survey does not demonstrate that the name BUNDT has lost its status as a common descriptive name. We believe the Board correctly held that appellant had not met its burden of rebutting the *prima facie* case that BUNDT is a common descriptive name.

The Board emphasized that the recipe in The Settlement Cook Book predates applicant's first use of the mark BUNDT on cake pans by at least twenty years, and that the recipes continued to appear in recent cookbooks of wide circulation. The various newspaper articles do not contradict the conclusion that BUNDT is known as the name of a type of cake, despite the retractions by some of the columnists. As the Board pointed out, "the significance of a generic term, especially in respect of foods, is clearly not restricted to the ethnic population from whose culture the term originated." *In re Northland Aluminum Products, Inc.*, 221 USPQ at 1113 (footnote omitted).

Having affirmed the Board's conclusion that BUNDT is a common descriptive name, neither obsolete nor obscure, evidence of secondary meaning can not change the result. *G.D. Searle*, 360 F.2d at 656, 149 USPQ at 624; *Cummins Engine Co.*, 359 F.2d at 865, 149 USPQ at 561-62; *Weiss Noodle Co.*, 290 F.2d at 848, 129 USPQ at 414.

C.

[1] Appellant urges us to consider its disclaimer, which appellant described somewhat expansively (since the disclaimer refers only to coffee cake), as accomplishing the result "that the registration now being solicited will not embarrass anybody's right to make a cake, to call a cake, or indeed to label a cake which he, she or it has made as being a 'bundt' cake." *In re Northland Aluminum Products, Inc.*, 221 USPQ at 1113.

The Board criticized the disclaimer as "meaningless" because "its effect would have been to leave no part of the mark which is registrable." *Id.* (footnote omitted). We agree with the Board that it is not of trademark significance to differentiate a cake made from a cake mix from a cake made from a recipe. Appellant argues that Pillsbury's BUNDT cake mix does not follow the traditional BUNDT KUCHEN recipe; but the Board

observed that the cake is shown in the traditional bundt shape. If as appellant argues its use of the name BUNDT is not descriptive of BUNDT cake, then it is confusingly misdescriptive; in neither case is the statute complied with. *Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 863, 132 USPQ 627, 634 (CCPA 1962) (immaterial that some of the so-called SUDSY ammonia products were not sudsy because they contained no detergent).

The Board also correctly found that the form of the lettering of the mark is "not so distinctive as to create a commercial impression separate and apart from the term BUNDT." *In re Northland Aluminum Products, Inc.*, 221 USPQ at 1113 n.9. The record is devoid of evidence of public recognition of this overall format as a trademark. *G.D. Searle*, 360 F.2d at 655-656, 149 USPQ at 623.

[2] On the totality of the evidence, we affirm the Board's decision that BUNDT is a common descriptive name for a type of ring cake, and is not registrable as a trademark for "ring cake mix."

AFFIRMED.

Court of Appeals, Federal Circuit

In re Thorpe, et al.

No. 85-1913

Decided November 21, 1985

PATENTS

1. Subject matter for patent monopoly — Process, product and apparatus (§51.613)

Determination of patentability in "product-by-process" claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is same as, or obvious from, product of prior art, even if prior product was made by different process.

2. Subject matter for patent monopoly — Process, product and apparatus (§51.613)

Patent and Trademark Office Board of Appeals did not err by affirming examiner's rejection of "product-by-process" claims, absent proof by applicant that prior art products do not necessarily or inherently possess characteristics of his claimed product.

Particular patents — Color Developers

Thorpe, et al., application, Improved Process for Metal-Modified Phenolic Novalac Resin, rejection of claims 44-47 affirmed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Donald H. Thorpe, et al., Serial No. 132,739, filed March 24, 1980. From decision affirming examiner's decision rejecting claims 44-47, applicants appeal. Affirmed.

James F. Tao, Niagara Falls, N.Y. (William G. Gosz, Niagara Falls, N.Y., on the brief) for appellants.

Richard E. Schafer, Associate Solicitor (Joseph F. Nakamura, Solicitor, and Fred E. McKelvey, Deputy Solicitor, on the brief) for Patent Office.

Before Davis and Newman, Circuit Judges, and Nichols, Senior Circuit Judge.

Newman, Circuit Judge.

We affirm the judgment of the United States Patent and Trademark Office Board of Appeals (the Board), which upheld the examiner's rejection of product-by-process claims 44, 45, 46, and 47 of U. S. Patent Application Serial No. 132,739 of Donald H. Thorpe *et al.* (Thorpe), filed March 24, 1980 for "Improved Process for Metal-Modified Phenolic Novolac Resin".

Background

The invention relates generally to color developers in carbonless copy paper systems. Such systems include a top sheet having microcapsules of a color-former coated on its back, and a copy sheet coated with a color-developer on its face. The color-former microcapsules rupture upon pressure of a writing instrument and release chromogenic material that reacts with the color-developer on the copy sheet.

It is known to use, as color developer, a novolac (sometimes spelled "novolak") phenol-aldehyde resin having an incorporated metal salt. Such materials had been produced prior to Thorpe's improvement, by heating the novolac resin with an organic metal salt such as zinc dibenzoate or zinc dipropionate in the presence of a weak base such as ammonia. In face of the prior art's teachings against the use of metal oxides with novolac resins, Thorpe discovered a process for making a metal-modified novolac color developer by reacting a novolac resin, a metal oxide or its functional equivalent, an ammonia base, and a mono-carboxylic acid. Claim 1 is the broadest claim:

1. In the process of preparing a metal-modified novolac phenolic resin wherein the metal is selected from the group consisting of copper, aluminum, zinc, chromium, in-

dium, tin, cadmium, cobalt and nickel, by reaction of a compound of said metal, an ammonia base and a novolac phenolic resin at an elevated temperature sufficient to maintain the reaction mixture in molten condition, the improvement comprising charging as reactants an oxide of the metal or the functional equivalent of said oxide, a mono-carboxylic acid selected from the group consisting of C₁₋₁₂ alkanolic acids and aromatic carboxylic acids of the benzene or naphthalene series, an ammonia base and the novolac phenolic resin.

The claimed process differs from the prior art in Thorpe's use of the metal oxide and carboxylic acid as discrete reactants, replacing the more expensive preformed metal carboxylate. These process claims were allowed. The claims which are the subject of this appeal are four product-by-process claims, of which claim 44 is typical:

44. The product of the process of Claim 1.

The Board affirmed the examiner's rejection of the product-by-process claims under 35 U.S.C. § § 102(b), 102(e), and 103, in view *inter alia* of the reference to Mueller showing zinc dibenzoate in the same novolac resin compositions, and the Kikuga or Stolfo references which show novolac-ammonia base compositions modified with zinc carboxylates; which the Board described as the same product prepared by a different process.

The Board observed that the case law requires that the product itself meet all the requirements for patentability. The PTO's position is that Thorpe's assertion of patentability of his product under § § 102 and 103 is unsupported by evidence, and that the burden of coming forward with evidence was on Thorpe in view of the "admission" in his specification that his product has properties "about equal" to those of the prior art, and a page of Thorpe's notebook (filed under Rule 131) wherein he identified the process as forming "zinc benzoate in situ," the reagent shown in the prior art.

Thorpe contends that it was unexpected that the product, even if it were the same as that of the prior art, resulted from the process of his invention. Thorpe also argues that the PTO bears the burden of demonstrating that the products are the same, and that the PTO can not meet this burden by relying on Thorpe's own disclosures. Thorpe also argues that if the process is patentable, as has already been held, then product-by-process claims should also, without more, be patentable.

Analysis

[1] Product-by-process claims are not specifically discussed in the patent statute. The

practice and governing law have developed in response to the need to enable an applicant to claim an otherwise patentable product that resists definition by other than the process by which it is made. For this reason, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d Cir. 1935).

The patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F.Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Thorpe does not assert that the product of his process is different from the product of the prior art. Rather, Thorpe argues that the PTO has the burden of showing that the product of his process is the same as the product of the prior art. The burden of presenting a *prima facie* case of unpatentability resides with the PTO, as discussed in *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

The examiner asserted that Thorpe's product made using zinc oxide and benzoic acid is *prima facie* the same as the prior art product made using zinc dibenzoate. The PTO referred to Thorpe's documents of record as showing that Thorpe also believed that zinc dibenzoate is formed, and took Thorpe's statement that his resin's properties are "about equal" to the known resin as an acknowledgment of similarity. Thorpe invokes the principle that an applicant's own disclosures cannot be used to support a rejection of the claims, "absent some admission that matter disclosed in the specification is in the prior art." *In re Wertheim*, 541 F.2d 257, 269, 191 USPQ 90, 102 (CCPA 1976), and cases cited therein. However, Thorpe's purported "admissions" are of a different sort than those dealt with in *Wertheim*.

Thorpe's description of the chemistry of his process as producing the same product as the process of the prior art is a statement of chemical fact, part of the description of Thorpe's invention. It was not Thorpe's dis-

closure of "zinc benzoate in situ" that was used by the PTO as prior art; it was the Mueller reference that taught the use of zinc benzoate. The examiner compared the product of the prior art, and the product of Thorpe's process as described by Thorpe, in accord with standard examination practice, noting the similarity of reactants, reaction conditions, and properties.

[2] Thorpe argues that even if the performance of a compound is comparable to that of the prior art, this fact does not necessarily imply that the structures are identical. We agree. We also agree that on the entirety of the record the PTO had correctly adduced a *prima facie* case, and that the burden had shifted to Thorpe, "to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product." *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). This Thorpe did not do. We conclude that the Board correctly affirmed the examiner's rejection of claims 44 through 47.

Policy Issues

Thorpe acknowledges the controlling precedent of this court and the Court of Customs and Patent Appeals, as discussed *supra*, and invites us to overrule this precedent. Thorpe argues that as a matter of public policy a patent applicant should be entitled to product-by-process claims whether or not the same product was previously produced by some other process. He argues that no harm is done thereby, no patent rights are extended, and that the case law is unduly restrictive.

Thorpe reminds us of the principle that an inventor is entitled to claim an invention in the inventor's choice of terms, and argues that this entitles him to claim the product as produced by his admittedly patentable process. Thorpe states that a product-by-process claim is only infringed when the process of the claim is used, and that the grant of product-by-process claims merely enables a fairer scope of enforcement to an inventor's statutory right to exclude.

Thorpe has directed our attention to pending legislation, which he states would change the law we are here applying. It is the province of Congress to make changes in law based on public policy. We do not agree with Thorpe that we should act in anticipation of possible action by the legislature. To the contrary. It is inappropriate for a court to abandon long-standing precedent, were it in our power and inclination to do so, on the eve of congressional consideration. *Roche Products v. Bolar Pharmaceutical Co.*, 733 F.2d 858, 865, 221 USPQ

937, 942 (Fed. Cir. 1984), *cert. denied* 105 S. Ct. 183, 225 USPQ 792 (1984).

AFFIRMED.

District Court, District of Columbia

Lucasfilm Ltd. v. High Frontier, et al.

Nos. 85-3609 and 85-3668

Decided November 26, 1985

TRADEMARKS

1. Infringement — In general (§67.431)

UNFAIR COMPETITION

In general (§68.01)

Trademark "Star Wars" only protects its owner against those who seek to attach such words to competing products or services, to noncompeting services that dilute value of mark, or to goods and services that disparage goodwill value of "Star Wars," and does not protect against use of phrase "star wars" to refer to Reagan Administration's Strategic Defense Initiative, nor does use of such phrase, in messages by groups debating value of such initiative, constitute "service" within meaning of Lanham Act.

2. Marks and names subject to ownership — Descriptive — Misdescriptive or not descriptive — Particular marks (§67.5078)

Use of "star wars" phrase in political propaganda, newspapers, or non-commercial, non-trade references does not undermine registered trademark owner's exclusive property right to use mark "Star Wars" in connection with goods or services, does not affect mark's distinct, and still strong, secondary meaning in trade and entertainment, and does not affect registered owner's right to prevent infringing uses of mark.

Consolidated actions by Lucasfilm Ltd., against High Frontier, et al., and Committee for a Strong, Peaceful America, et al., for trademark infringement. Judgment for defendants.

See also 227 USPQ 814.

Arthur J. Levine, Laurence R. Hefter, Jay L. Witkin, Philip J. Moy, and Thomas W. Gorman, all of Washington, D.C., for plaintiff.

Marianne Mele Hall, G. Lindsay Simmons, and Scott W. Woehr, all of Washington, D.C. for High Frontier, et al.

Mary Jacksteit, John McNally, Frederic C. Williams, and Anthony Parker, all of Washington, D.C., for Committee for a Strong, Peaceful America, et al.

Gesell, District Judge.

These two complaints alleging infringement of plaintiff's STAR WARS trademark involve the same questions of law and substantially similar facts. The suits have been consolidated and plaintiff's motion for preliminary injunction in each case will be treated as submitting the issues for final resolution on the merits pursuant to Fed. R. Civ. P. 65(a)(2). The Court has received briefs, affidavits and heard full oral argument by counsel for all parties.

Not so long ago, in a studio far, far away from the policymakers in Washington, D.C., George Lucas conceived of an imaginary galaxy where fantastic creatures and courageous knights battled an evil empire with spaceships, "blaster" guns and light sabers. Plaintiff Lucasfilms Ltd. marketed this imaginative fantasy in three enormously popular films, the first of which was entitled "STAR WARS." STAR WARS has since become a strong trademark owned by plaintiff and registered as a service mark under the Lanham Act. 15 U.S.C. § 1051-1127. Plaintiff has built on the national success of these movies and the goodwill associated with STAR WARS by using the STAR WARS mark to merchandise dolls, toys, comic books, cookies, paper cups, watches, candles and even bubble bath.

Meanwhile, in the real world of defense strategy and international politics, newspapers, politicians, scientists and spokesmen of allied and enemy nations have chosen to characterize the Reagan Administration's Strategic Defense Initiative (SDI) as its "star wars" program. SDI seeks to develop defenses against a nuclear attack with weapons based in space somewhat reminiscent of those depicted in the STAR WARS movies. See some SDI as a brilliant proposal full of promise. Others fear the idea will simply escalate the risk of nuclear war and frustrate efforts toward disarmament. An intense political debate is under way and still raging. Through persistent and prolific use in newspapers and magazines and over television and radio the phrase star wars has become a popular synonym for the SDI proposal.

The principal defendants are public interest groups aligned on opposite sides of this political controversy. Both have chosen to express their views through television message which refer to SDI as star wars. Except for their viewpoint, defendants' television messages are similar; both focus on a child's response to space defenses against a nuclear attack. In